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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,612	12/05/2000	Dave Stephens	021756-065800US	7393
51206 7590 09/18/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
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09/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/730,612

Applicant(s)

STEPHENS ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/2009 has been entered.

Heading

The affidavit/declaration of **Stephens et al.** filed on 6/30/2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the reference **Covisint**.

Failure to establish diligence

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Covisint reference to either a constructive reduction to practice or an actual reduction to practice. In the present case, the applicant's have not properly established diligence through sketches, notebook entries, etc. for the ***entire*** time from prior to the date of the Covisint reference up to the date of reduction to practice. "An applicant must account for the entire period during which diligence is required." *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). Statements that the subject matter "was diligently reduced to practice" is

not a showing "but a mere pleading." *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964). Diligence requires that Applicants must be specific as to dates and facts. *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949). (Also see MPEP 2138.06). Given the affidavits broadest reasonable interpretation, considering the dates of exhibits B-E have been redacted, based on provided information the filing date of the application the reduction to practice is the filing date. Considering also that there was no activity for over 3 months, the affidavit does not establish diligence throughout the entire period between August 15 and December 5, 2000.

Failure to establish conception

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the PR Newswire reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In the present case, the applicants have not properly supported their conception of the invention through sketches, notebook entries, programming code, etc. In particular, as best understood by the examiner exhibit A discloses that a B2B hub with multiple partners was known and that the novelty of the disclosure is that the each partner would have a branded site with a URL that was not necessary. Exhibit A does not indicate that applicant was in possession of the following: claim 1 – "wherein the

common instance comprises a database divided into a plurality of sub- schemas, and wherein each of the exchanges is singularly associated with and implemented within a respective one of the plurality of sub-schemas providing a respective partial view of the common instance, and wherein each of the exchanges is allocated to a different merchant" claim 10 - "a) defining a common instance using a common schema that defines a database; b) slicing the common instance into a plurality of exchanges, wherein the common instance is divided into a plurality of sub-schemas, and wherein each of the exchanges is singularly associated with and is implemented within a respective one of the plurality of sub-schemas providing a respective partial view of the common instance and wherein each of the exchanges is allocated to a different merchant; c) implementing a common support architecture for the exchanges; d) implementing efficient communication between a first exchange of the exchanges and a second exchange of the exchanges using the common support architecture; a common database for implementing the exchanges within a common schema", or in the case of claim 20 – "the exchanges sharing a set of common components and each exchange having a respective view having respective unique components, wherein the common schema is divided into a plurality of sub-schemas, and wherein each of the exchanges is singularly associated with and is implemented within a respective one of the plurality of sub schemas providing a respective partial view of the common schema, and wherein each of the exchanges is allocated to a different merchant, and wherein the exchanges each have a respective operator, allowing an operator to perform input/output using the common components to perform the input/output for each of the exchanges". Therefore,

based on the affidavit and the lack of dates, the examiner understands the conception, where all the features of the instant claims were understood by the applicant, is 12/5/2000.

Failure to reduce to practice (Actual)

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the PR Newswire reference. An actual reduction to practice requires a showing of the invention in a physical or tangible form that shows every element of the count. See *Wetmore v. Quick*, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985); (Also see MPEP 715.02 and 715.07) In the present case, the evidence submitted by the applicants fails to show the claimed limitations of claim 1 – “wherein the common instance comprises a database divided into a plurality of sub-schemas, and wherein each of the exchanges is singularly associated with and implemented within a respective one of the plurality of sub-schemas providing a

respective partial view of the common instance, and wherein each of the exchanges is allocated to a different merchant” claim 10 - “a) defining a common instance using a common schema that defines a database; b) slicing the common instance into a plurality of exchanges, wherein the common instance is divided into a plurality of sub-schemas, and wherein each of the exchanges is singularly associated with and is implemented within a respective one of the plurality of sub-schemas providing a respective partial view of the common instance and wherein each of the exchanges is allocated to a different merchant; c) implementing a common support architecture for the exchanges; d) implementing efficient communication between a first exchange of the exchanges and a second exchange of the exchanges using the common support architecture; a common database for implementing the exchanges within a common schema”, or in the case of claim 20 – “the exchanges sharing a set of common components and each exchange having a respective view having respective unique components, wherein the common schema is divided into a plurality of sub-schemas, and wherein each of the exchanges is singularly associated with and is implemented within a respective one of the plurality of sub schemas providing a respective partial view of the common schema, and wherein each of the exchanges is allocated to a different merchant, and wherein the exchanges each have a respective operator, allowing an operator to perform input/output using the common components to perform the input/output for each of the exchanges”. Therefore, based on the affidavit and the lack of dates, the examiner understands the conception, where all the features of the instant claims were understood by the applicant, is 12/5/2000.

Please also note that applicant uses the year 2005 in para 5 and 6 of the affidavit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,6,7,8,9,10,11,13,16,17,18,19,20 are rejected under 35

U.S.C. 103(a) as being unpatentable over Covisint (a collection of articles Covisint1,2,2.1 and 3) or Oracle (a collection of articles Oracle1-7), in view of King (5,319,542) in view of Kaplan (US 5,701,460).

In regards to claim 1,10,20, Covisint or Oracle discloses a multiple exchange (ecommerce portal) instance, comprising:

a plurality of exchanges (ecommerce portal); and

a common instance for implementing the exchanges (Covisints' B2B exchange, common exchange, Covisint3, Oracle1, page 2, "rival carmakers will be welcome to use Autoexchange".),

Covisint or Oracle teaches the exchanges sharing a set of common components (sharing the common technology of the Covisint exchange, Ford, GM, DaimlerChrysler, or sharing Oracle1's autexchange) and each exchange (ecommerce portal), but does not specifically mention having a respective view having respective unique components. King teaches a common instance with personalized views (King, public and private catalogs). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Covisint or Oracle having a respective view having respective unique components as is taught by King, because this would permit different exchanges to use the components that best suit their needs within the common instance to provide flexibility, thus increasing revenue by having different companies on one localized exchange.

wherein the common instance comprises a database divided into a plurality of sub-schemas (Covisint3 page 3 , different sub-schemas within one exchange sharing a common instance, Covisint, and having sub-schemas that protect the information),

Applicant may argue that the references do not teach sub-schemas, for this reason Kaplan is offered as an example of how sub-schemas are used in a relational database to produce a view of just a portion of an entire database as directed by the sub-schema (Kaplan, col 2, lines 1-20) It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Covisint or Oracle and King the use of sub-schemas, because this provides only the data that the user wishes to use thus reducing clutter on the web site screen.

wherein each of the exchanges (ecommerce portal) is implemented within a respective one of the sub-schemas providing a respective partial view of the common instance (King, custom catalogs), and
wherein each of the exchanges (ecommerce portal) is allocated to a different merchant (Covisint, Ford, GM, DaimlerChrysler, other automobile makers/competitors).

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

In regards to claim 3,13 the combination of Covisint, Oracle, and Kaplan teach wherein the multiple exchanges each have a respective operator, and wherein the multiple exchange instance allows each operator to perform input/output using the common components to perform the input/output for each of the multiple exchanges

(Covisint3, each automaker makes their own orders using the Covisint exchange, Oracle4, allows buyers and sellers to interact seamlessly).

In regards to claim 6,16 the combination of Covisint, Oracle, and Kaplan teach wherein the common input/output comprises a registration operation for each of the exchanges (Oracle6, Covisint2.1,).

In regards to claim 7, 17 the combination of Covisint, Oracle, and Kaplan teach wherein the multiple exchanges are configured to use communication protocols to communicate with processes external to the common instance (Oracle7, Integration software for communication with businesses over the internet that uses protocols of either Java or XML, Covisint2.1.1).

In regards to claim 8,18, the combination of Covisint, Oracle, and Kaplan teach wherein the communication protocol is XML (See claim 7 above).

In regards to claim 9,19, the combination of Covisint, Oracle, and Kaplan teach wherein the common instance is implemented using a database program running on one or more computer systems (see response to claim 1).

In regards to claim 11, Covisint teaches wherein the exchanges share a set of common components within the common support architecture and wherein the custom view has respective unique components (see response to claim 1).

Claims 2,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covisint (a collection of articles Covisint1-3) in view of Oracle (a collection of articles Oracle1-7, in view of King in view of Kaplan (US 5,701,460) and further in view of Admitted Prior Art (APA) (US PG PUB 20020069120 to Stephens)

In regards to claim 2,12 the combination of Covisint Oracle, and Kaplan teach the multiple exchanges are implemented within the common instance and wherein the common instance facilitates communication between a first exchange of the exchanges and a second exchange of the exchanges. (Covisint3, common technology platform), facilitates communication between exchanges (Covisint3, all parties may examine stock levels of common suppliers, and Covisint page 30 collaborative product design) and Covisint2.1 page 24, "facilitated communication and collaboration between automakers and suppliers as well as across suppliers". Further, it is noted that APA teaches facilitating communication between the exchanges was old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to communicate between suppliers since each company may benefit by knowing the levels of use of inventory at a shared supplier and can make more informed decision thus saving money by not having to order as often.

Claims 4,5,14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covisint (a collection of articles Covisint1-3) in view of Oracle (a collection of articles Oracle1-7, in view of King, in view of Kaplan (US 5,701,460) and further in view of Official Notice

In regards to claim 4,14 the combination of Covisint, Oracle, and Kaplan teach input and out put from a common portal, but does not specifically mention that there is an authentication operation for each of the exchanges, The examiner takes official notice that the use of authentication techniques when entering a portal was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Covisint and Oracle, authentication by a user, because this will prohibit unauthorized suppliers from entering the portal and provide for a charging mechanizing to assure that fees were paid.

In regards to claim 5,15 the combination of Covisint, Oracle, and Kaplan teach the use of a catalog method within an exchange (oracle5), but does not specifically mention that the catalog has input and output. The examiner takes official notice that it was old and well known in the art at the time of the invention to permit input and output to an online catalog. It would have been obvious to a person having ordinary skill in the art a the time of the invention to include in Covisint, Oracle, and Kaplan to permit input

and output to an online catalog , because this is important to assure that a product is in the common catalog for customers to peruse, since if the operator was using a catalog model and no information was in the catalog or a buyer was not able to access the catalog then no transaction would result and revenue from providing transactions would be significantly reduced.

Claim 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covisint (a collection of articles Covisint1-3) in view of Oracle (a collection of articles Oracle1-7, in view of Kaplan (US 5,701,460) in view of Official Notice and further in view of King et al (US 5,319,542)

In regards to claim 21, the combination of Covisint, Oracle and Official Notice teach registering to enter an exchange portal for updating information (covisint2.1 page 15, , but does not specifically mention that the registration is for a group of exchanges simultaneously. King teaches updating a public catalog which is accessed by a plurality of exchange partners and is also used to simultaneously update private catalogs that are unique to each of the exchange buying entities. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Covisint, Oracle and Official Notice, the updating of all common elements with one registration because this would save time by the supplier by only having to enter that data once thus saving time and assuring that that common element of the product catalog are consistent.

Response to Arguments

Applicant's arguments filed 6/30/2009 have been fully considered but they are not persuasive.

In response to applicant's request for a reference regarding the taking of official notice in the 4/9/2008 office action, the use of official notice not been seasonably traversed and therefore the features contained in claims 4,5, 15 and 16 are taken to be admitted prior art.

In regards to claims 2 and 12, applicant argues that the communication is not on a common instance. The examiner notes in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In regards to applicant's argument that APA does not teach communication between exchange partners, the examiner directs the applicant's attention to both para 0008 and 00030 where it is clearly stated that the industry standard XML may be used to facilitate communications between the businesses in a manner that is obvious and predictable.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pushing catalog content) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to claims 1-9 and 20, Applicant appears to agree that the combination of Covisint or Oracle, King and Kaplan does teach the broadly recited features but argues that the references do not enable the claimed invention. The examiner disagrees and notes that the combination of Covisint or Oracle, King and Kaplan clearly describe the broadly encompassing features of the instant invention. One skilled in the would understand that computers would be necessary to execute the applications that define the backbone of the common exchange used for providing to a world wide automotive supply chain a broad range of services including catalog services, auction services, sourcing services, financial services...payment and logistics (Covisint2). Clearly the global exchange described in the prior art, including applications such as Release 11i, would not be broken down to their base functionality and then implemented without the use of its intended computerized functionality on the internet. And further Covisint2.1 pages 25, 26 and 30 and Covisint2.1.1 clearly articulate how XML is used in a web based architecture to allow all parties to interact in a common instance.

Official Notice Traverse

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

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Alexandria, Va. 22313-1450

or faxed to:

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For general questions the receptionist can be reached at
571.272.3600

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/Mark Fadok/

Primary Examiner, Art Unit 3625